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| 10/686,266 | 10/14/2003 | Thomas David Kehoe | | 7234 |

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| EXAMINER |
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HAMILTON, MATTHEW L

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| ART UNIT | PAPER NUMBER |
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3622

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10/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/686,266

Applicant(s)

KEHOE, THOMAS DAVID

Examiner

Matthew L. Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the initial filing filed on 14 October 2003.
2. Claims 1-20 are currently pending and have been examined.
3. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim Objections

4. Claim 5 is objected to because of the following informalities: Claim 5 is dependent on claim 6. The Examiner believes this is a typographical error and that claim 5 should depend on claim 4. The examiner will assume claim 5 is dependent on claim 4 when considered below. Appropriate correction is required.
5. Claims 4, 5, 12, 13, 18 and 19 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. For example, dependent claim 4 is written as: **A computer database system which enables said publisher to reward said reader for recommending said bound printer matter according to claim 1.** The dependent claim 4 should be written as: **Bound printed matter including media according to claim 1, includes a computer database...(to perform something).** The

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example clearly illustrates a connection between independent claim 1 and dependent claim 4, which limits the claim.

6. Claims 3, 7, 11, 17 and 20 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The applicant used the wrong preamble. For example, the preamble for dependent claim 3 states: **Media according to claim 2**. The correct method to write the preamble for dependent claim 3 is the following: **Bound printer matter including media according to claim 2**. The claim should be written the same way for dependent claim 7 and so forth.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 2, 10, 11, 14, 16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear whether the claims refer to one or two types of medium.

9. Claims 5, 13 and 19 recite the limitation "a reward". Claim 10 recites the limitation "Sound recording media and media". Claims 11, 14, 17 and 20 recite the limitation "media". Claim 16 recites the limitation "Video recording media and media". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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11. Claims 1-20 are rejected under 35 U.S.C. 101 because the claims recite intended use, printed matter and recording media are not statutory. A printed matter does not perform an action, has no structure or process. A recording media does not produce a product, process or machine. Therefore, the printed matter and recording media do not produce a useful, concrete and tangible result. The applicant is advised to amend the claims and convert them to method claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 7-9, 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg in view of Suliman Jr. et al. US Publication 2001/0053980 A1 and Werling US Publication 2004/0007868 A1.

Claims 1, 9 and 15:

As per claims 1, 9 and 15 **Goldberg** teaches media that:

a) encourages a reader of said bound printed matter to recommend said bound printed matter to one or more other person (Goldberg, Carole, Courant Books Editor Hartford Courant page G3). The reader can recommend the printed matter for example, a book to another person. Similarly, the listener can recommend listening to a particular kind of music and a viewer can recommend watching a certain type of movie or television program.

Goldberg does not teach *b) said media enables said reader to register and bound printed matter with said bound printed matter's publisher.* However, **Suliman Jr. et al.** teaches a method and system for blind electronic warranty registration in paragraph 0002 and further teaches *"To best serve the consumer,*

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manufacturers often request that the consumer register the product with the manufacturer by way of a return postcard” and “Additionally, many manufacturers use the return of these postcards to obtain not only personal information such as name and address of their consumers, but demographic information to help them in their marketing and research and development effort.” (paragraph 0003). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for Goldberg to register reader's printed matter with printed matter's publisher. One would have been motivated to register reader's printed matter with printed matter's publisher in order to gather data regarding the consumer's demographics and for marketing purposes. For clarification purposes, the Examiner cites Suliman Jr. as analogous art. The consumer can be construed as the reader and the manufacturer as the publisher in the citation of Suliman Jr.

Goldberg does not teach *and c) is printed with a unique alphanumeric identifier*. However, **Werling** teaches methods and devices for identifying individual products in paragraph 0001 and further teaches, *“Unique identifier 25 may include any suitable means for uniquely identifying individual books. For example, unique identifier 25 may be a unique number, symbol, bar code or combination thereof. One advantage of using a bar code as the unique identifiers of this invention is that publishers, manufacturers and other sellers may use existing bar code reader technology. Most publishers already use barcode readers for reading inventory and sales control barcodes 23, 26. Thus, a method based upon unique bar codes can be incorporated into existing tracking systems used by publishers with minimal or no additional cost.”* (paragraph 0033 and see figure 1 items 23, 25 and 26). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for Goldberg to print a unique alphanumeric identifier. One would have been motivated to print a unique alphanumeric identifier in order to easily identify books, inventory and prevent fraudulent activities.

Claims 7, 8, 14 and 20:

As per claims 7, 8, 14 and 20, **Goldberg, Suliman Jr. and Werling** teaches the printer matter of claim 1, sound recording media of claim 9 and video recording media of claim 15 as described above but

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does not teach *in which said media offers a reward to said person(s) to whom said bound printed matter is recommended*, nor that *said reward is a lower price to buy said bound printed matter*. However, official notice is taken that is old and well known to offer discounts for products in order to entice a person to purchase the product. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for Goldberg offer a discount reward to the person who has been recommended a printed matter in order to persuade them to buy the printed matter.

13. Claims 2-3, 10-11 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg in view of Suliman Jr. et al. US Publication 2001/0053980 A1 in view of Werling US Publication 2004/0007868 A1 as applied to claims 1, 7-9, 15 and 20 above, and further in view of Zorn US Patent 6,276,724 B1.

Claims 2, 10 and 16:

As per claims 2, 10 and 16 **Goldberg, Suliman Jr. and Werling** teaches the printer matter of claim 1, sound recording media of claim 9 and video recording media of claim 15 as described above. **Goldberg, Suliman Jr. and Werling** does not teach *in which said media and bound printed matter are one or more postcards bound into a book*. However, **Zorn** teaches an advertising brochure and method for its use in column 1, lines 10-12 and further teaches *"Advertising and promotional inserts are well known for magazines and other types of periodicals. These inserts can be as simple as a postcard insert that is placed between two pages of a magazine..."* and *"Another type of insert is an attached postcard that is secured to the magazine by, for example, the center staples used to bind the pages of the magazine."* (column 1, lines 16-19 and 22-24). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for Goldberg to bind postcards into a book. One would have been motivated to bind postcards into a book in order to advertise and increase the popularity of the business and increase profits. A book is defined as a written or printed work of fiction or nonfiction, usually on sheets of paper fastened or bound together within covers by dictionary.com. A magazine can be interpreted as a type of book with various written printed work such as stories or essays.

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Claims 3, 11 and 17:

As per claims 3, 11 and 17, **Goldberg, Suliman Jr., Werling and Zorn** teaches the printer matter of claim 2, sound recording media of claim 10 and video recording media of claim 16 as described above and **Suliman Jr.** further teaches *in which media includes a postcard with form spaces for said reader's name and address, and said unique alphanumeric identifier, and a preprinted address for mailing said postcard to said publisher* (paragraph 0003). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for **Goldberg** to include a postcard with spaces for reader's name and address, unique alphanumeric identifier and preprinted address for mailing. One would have been motivated to include a postcard with spaces for reader's name and address, unique alphanumeric identifier and preprinted address for mailing in order to identify the customer(s) and product(s) and to have a preprinted address to forward this information to the publisher.

14. Claims 4-6, 12-13 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Goldberg** in view of **Suliman Jr. et al.** US Publication 2001/0053980 A1 in view of **Werling** US Publication 2004/0007868 A1 as applied to claims 2-3, 10-11 and 16-17 above, and further in view of **Page et al** US Publication 2005/0102197 A1.

Claims 4,12 and 18:

As per claims 4, 12 and 18, **Goldberg, Suliman Jr., and Werling** teaches the printer matter of claim 1, sound recording media of claim 9 and video recording media of claim 15 as described above. **Goldberg, Suliman Jr., and Werling** does not teach *a computer database system which enables said publisher to reward said reader for recommending said bound printed matter*. However, **Page et al.** teaches message-based referral marketing in paragraph 0001 and further teaches *"The invention facilitates storage of a database record identifying (i) the purchaser, (ii) a plurality of contacts designated by the purchaser, and (iii) contact information (e.g., e-mail addresses) facilitating communication with the contacts."* and *"The present invention allows the service to give the customer the option to create a message (or append a promotion to an otherwise non-promotional message) that may result in a reward*

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to the customer." (paragraphs 0007 and 0008). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for Goldberg to reward reader for recommending printer matter. One would have been motivated to reward reader for recommending printer matter in order to increase profits and consumer awareness of the businesses products and services. However, while the publication of Page does not disclose ~~about~~ a reader, it does describe the limitations of the present application by storing information of readers (customers) and rewarding them for recommending a product.

Claims 5, 13 and 19:

As per claims 5, 13 and 19, **Goldberg, Suliman Jr., Werling and Page** teaches the printer matter of claim 4, sound recording media of claim 12 and video recording media of claim 18 as described above but does not teach *in which said reward is remuneration*. However, it would have been obvious to one of ordinary skill in the art at the time of the invention of Goldberg to add a monetary reward, such as a discount. According to Webster's II New Riverside Dictionary, remuneration is defined as: to pay (someone) for goods and services.

Claim 6:

As per claim 6, **Goldberg, Suliman Jr., Werling and Page** teaches the printer matter of claim 4 as described above and **Page** further teaches *which enables said publisher to evaluate the effectiveness of marketing programs* (paragraph 0006). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for Goldberg to evaluate the effectiveness of marketing programs. One would have been motivated to evaluate the effectiveness of the marketing programs to understand which products are popular and comprehend whether the marketing program is successful or needs improvement.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Hamilton whose telephone number is (571) 270-1837. The examiner can normally be reached on Monday-Friday 7:30a.m-5p.m EST alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

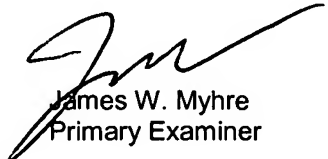
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Matthew Hamilton

Patent Examiner

September 25, 2007

mt


James W. Myhre
Primary Examiner